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21906 7590 01/26/2007  
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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/584,520

Applicant(s)

LEGLISE ET AL.

Examiner

Yehdega Retta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 39-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This office action is in response to non-final response filed October 16, 2006. Applicant amended claims 51, 52 and 54-56. Claims 39-62 are still pending.

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 51 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claim recites establishing an Internet connection between said machine and a service provider, said connection other than through a retail vendor's web site. The claim also recites said user required to view said first graphical user interface before being enabled to use the machine to access the Internet for general-purpose use, the first graphical user interface to include an indicator of said particular retail vendor and a first user-selectable option, said first graphical user interface without an indicator of another, unrelated retail vendor. Applicant specification teaches that the interface is branded with vendor's name (see fig. 2 and 3).

Applicant's specification also teaches, see pp 7 & 8, through interaction between a service provider and a retail vendor, a processor-based system at a customer's home or other location may be advantageously operated to facilitate the interests of the customer and the retail vendor. The customer being asked to provide information to the service provider, who is independent

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from the retail vendor, to customize the options afforded to the customer on the customer's processor-based system and the service provider provides Internet services to the customer on behalf of the retail vendor. The specification teaches in return for those services, the customer is requested to first receive content related to the products or services of the retail vendor before accessing the Internet services from the service provider". Therefore, it is through the vendor's web site that the connection is established. Since applicant does not teach establishing Internet connection between the machine and the service provider other than through a retail vendor's web site, it is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites establishing Internet connection between a machine and Internet provider, the connection other than through a retail vendor's web site, and also claims said user required to view said first graphical user interface before being enabled to use the machine to access the Internet for general-purpose use, the first graphical user interface to include an indicator of said particular retail vendor and a first user-selectable option. It is unclear how the connection is established other than through a retail vendor's web site and the first graphical user interface, which the user is required to view before being able to access the Internet, to include indicator of the retail vendor. Applicant is required to claim with positive limitation by indicating what connection is used for the user to access the Internet rather than what is not used.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-45, 47-57, 59-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd Judd Erickson "Get Subscribers Get Them Online And Start Making More Money" hereinafter Erickson and further in view of Ziplink's Virtual Internet Service Provider (ISP) Program Provides complete Turnkey Outsourcing Option PR Newswire; New York; Nov 4, 1999 (hereinafter ZipLink).

Regarding claims 39-41, 51-53, 62 and 65 Erickson teaches providing information of a user to service provider; receiving a first graphical interface from the service provider said user required to view the first graphical interface before being enabled to access the Internet (providing CD that connects new subscribers to its network, add multiple users to a single household account; add a desktop interface for the user similar to AOL) (see page 76 col. 1); Erickson teaches the Netkit CD-ROM gets the new subscriber online, sets up an account and arranges the account preferences and settings, once the user has finished all the sign-up wizards, Netkit posts the data to a sever that sets up the account, including billing (see page 78 col. 1). Erickson further teaches AOL uses its desktop application to control what the user sees and when- to a certain extent. AOL users can fire up the AOL interface and go directly to one of AOL's "channels" for specific content such as sports or weather or shopping. Erickson further

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teaches any ISP can have a branded desktop, with its own channels and content partners and using the ISP-branded interface a user has access to the Web, e-mail and direct access to the ISP's content partners. Erickson further teaches the Netsurfer prevents the user from getting to e-mail or the Internet without using the desktop i.e. viewing the first graphical interface before being enabled to access the Internet (user selectable option to access the Internet or any channels provided by the ISP or email or direct access to the ISP's content); setting up processor-based computer (user computer) to receive services from the Internet provider (see page 78 col. 2 &3) and after selecting one of the selectable options providing a second interface i.e. the browser to access web sets or e-mail etc..Erickson teaches establishing an Internet connection between a machine (client computer) and a service provider, the connection other than through a retail vendor's web site (through the ISP's interface).

Erickson failed to teach the ISP providing the service on behave of a retail vendor. Ziplink teaches providing private-branded Internet connectivity, **which enables e-businesses, affinity groups and web-centric organizations**, etc. to become Virtual ISPs, which implies that customers obtaining Internet service through the vendor see a graphical interface from the vendor not from Ziplink. Ziplink teaches "(w)ith the rollout of the Ziplink's Virtual ISP Program, the Company (vendors) now offers a full suite of customer care management services" including; custom sign-up, activation and authentication; customer support; billing and collection, branded CD, e-mail and news service, etc. Ziplink teaches coupled with Ziplink's national dial-up and Digital Subscriber Line (DSL) Internet connectivity, these new value-added services comprise a complete ISP outsourcing option. Ziplink teaches by using the system customers (vendors) avoid the tremendous investment of building and maintaining a national network and the cost of

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staffing a customer care operation center (see page 1). It would have been obvious to one of ordinary skill in the art at the time of the invention for any ISP using the Netsurfer's system to provide the service on behalf of other companies as taught in Ziplink. Since the companies would be able to provide the service, and customers would see the site every time they log on, which provide more opportunities for customers to purchase products or services the company offers, without the companies investing on a network, equipment or customer support customer. Netsurfer teaches the second user interface to include customized content that is based on the user information provided to the service provider; receiving preference of one or more user's of said processor-based system (page 80 see col. 1 & 2).

Regarding claims 42 and 54, Erickson teaches the interface to enable identification of a user that is actively logging on the system (see page 80).

Regarding claims 43 and 55, Erickson teaches receiving a third graphical interface that includes selectable options not related to the particular vendor. This feature is inherent to the user accessing the Internet, which provides information on any vendor or company that provides web site on the Internet.

Claims 44 and 56 are rejected as stated above in claim 39 or 51, since the claim recites the same limitation i.e., the user sees the ISP's site or the vendor which is providing the service, first before selecting one of the options to access the Internet or e-mail or partners site.

Regarding claims 45 and 57, Erickson teaches allowing the service provider to control the system (see page 78, AOL or using Netsurfer the ISP controlling the desktop).

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Regarding claims 47, 48, 59 and 60, Erickson teaches any user of the processor-based system to see the same first graphical user interface and said first interface received immediately after booting the system (see page 78).

Regarding claims 49 and 61, Erickson teaches receiving instructions from a remote system to control the addition of software and hardware (see page 80 col. 1).

Regarding claim 50, directing user to a server associated with the retail store is inherent feature of the user seeing the vendor site first and accessing the site.

Regarding claim 63, Ziplink does not teach a system including a unitary housing to house processor, display and a telephone. However official notice is taken that is old and well known to make separate parts as an integral of one piece. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the telephone as integral part of the computer terminal in order to make the terminal easy to transport.

Regarding claim 64, official notice is taken that is old and well known in the art of computers that a dedicated port is a readily available component of today's computer terminals. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that Ziplink would provide service through a dedicated port.

Claims 46 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd Judd Erickson "Get Subscribers Get Them Online And Start Making More Money" hereinafter Erickson and further in view of Ziplink's Virtual Internet Service Provider (ISP) Program Provides complete Turnkey Outsourcing Option PR Newswire; New York; Nov 4, 1999 (hereinafter ZipLink) further in view of Tobin (US 6,141,666).



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Regarding claim 46 and 58 Erickson does not teach providing advertising to user that is logged in based on preference of another user who is identified user of the system. Tobin teaches receiving reminder about others birthdays and receiving marketing information (col. 8 lines 41-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide advertisement based on other family member's birthdays or preference for the intended use of providing a reminder and suggesting gifts to the user as taught in Tobin.

### *Response to Arguments*

Applicant's arguments filed October 16, 2006 have been fully considered but they are not persuasive.

Applicant asserts that the first graphical user interface is to include an indicator of the particular retail vendor and a first user-selectable option, which is without an indicator of another, unrelated retail vendor. Applicant also asserts that claim 39 indicates that information about a user of processor-based system is sent to a service provider, the service provider being independent from a particular retail vendor. Applicant argues that Netsurfer merely makes the sign-up disk for Internet providers but does not provide the Internet service. Examiner agrees Netsurfer's CD is for signing up client. Examiner is also aware that the CD is for signing customer with a service provider. Erickson states "But merely useful does not begin to describe the services Netsurfer offers ISPs. With one Netsurfer CD, and its connected services, an ISP can produce one CD to:

- Carpet-bomb sign-up CDs to a targeted market or geographic region
- Connect new subscribers to its network
- Add multiple users to a single household account

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- Set up a Web and e-mail filter for children
- Add a desktop interface for the user, similar to AOL's
- Set up a client-side quality-of-service reporter.

Erickson further states, "The CD Netsurfer produces will help ISPs mass market their services, help new subscribers get online quickly and inexpensively, help parents control the type of material their kids are exposed to on the Web and in e-mail messages, help ISPs track the quality of service of their networks and help ISPs offer value-added services to increase profitability. One CD does it all. It's that easy".

I agree with Applicant that Erickson is silent as to an indicator of a particular retail vendor (that is not the ISP). Examiner relied on Ziplink, which discloses that ISP's can provide Internet service on behalf of retail stores, the only claimed feature Erickson does not disclose. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that any of the ISPs that use the Netsurfer to provide Internet service on behalf of a retail store for the advantage taught in Ziplink. Applicant argues that Ziplink does not discuss user interface and Ziplink does not cure Erickson's deficiency. Applicant seems to argue against the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner would like to point out that the user interface is disclosed in Erickson and it would be obvious to know that the ISPs of Erickson have the interface taught in Netsurfer for the advantage taught in Netsurfer. Applicant also argues that the second graphical user interface is received in response to selection of the first user selectable option (that is the

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login page). Erickson teaches the first graphical user interface is the login page. Erickson teaches "AOL uses its desktop application to control what the user sees and when to a certain extent. Not only does AOL make money on subscriber fees, but it charges content providers and e-commerce companies for space on its desktop program. Users can fire up the AOL interface and go directly to one of AOL's channels" for specific content, such as sports or weather, or shopping. Erickson teaches, "If there is more than one user on a particular computer, SoftCast has the ability to "narrowcast". The ISP can push content, updates or messages to a particular user, so no other user will see it. So, for example, if an TSP signs a deal with a financial planning site, and Mom, Dad, Junior and Wendy are all signed up on one account, only Dad or Mom may have his or her desktop program updated with the new icon". Further Erickson discloses that, "Another one of AOLs advantages is that it allows easy access and provisioning for multiple users on the same subscription account. So Dad, Mom, Junior and Wendy can all have their own usernames, passwords and e-mail accounts. So it is only after the interface login page i.e., after the user provides the login name or name and password that the user is provided with a second interface and it is after the user login that the interface is customized. Applicant argues that there is no motivation for the modification proposed by the examiner and the that Erickson teaches away from an interface that is dedicated to one particular retail vendor and no other vendors. Examiner would like to point out that Ziplink teaches the motivation to provide an Internet service on behalf of retail store. Examiner would like to point out that Erickson teaches one way of setting up a customized Internet service. Erickson teaches "(w)ith Netkit, any ISP can have a branded desktop, with its own channels and content partners. Using the ISP-branded interface, a user has access to the Web, e-mail (Netkit even raises the mailbox flag and plays a sound when

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mail is received) and direct access to the ISP's content partners. ISPs can customize the desktop interface in any way they choose". Ziplink teaches the Internet service customized so that the Interface is branded with the retail store. For this reason, Examiner could not see how the Erickson's article could teach away from the invention, when applicant's invention does not show how the interface is setup so that it is dedicated to only one retail store.

Regarding claim 51, applicant argues that the claim includes establishing an Internet service between the machine (user's computer) and a service provider, the connection other than through a retail vendor's web site. Examiner would like to point out that Erickson teaches establishing Internet service between client and service provider who are not retail vendors (not through a vendor's web site). Ziplink teaches establishing Internet service between client and ISPs on behalf of vendor i.e., the Interface is branded with the vendor's name but is provided by an ISP, so the connection is through the Internet service provider not the vendor. Examiner would like to point the applicant to the specification which teaches "(t)hrough interaction between a service provider and a retail vendor, a processor-based system at a customer's home or other location may be advantageously operated to facilitate the interests of the customer and the retail vendor. The customer may be asked to provide information to the service provider, who is independent from the retail vendor, to customize the options afforded to the customer on the customer's processor-based system. The service provider provides Internet services to the customer on behalf of the retail vendor". Same as Ziplink's branded Internet service. According to applicant according to the embodiment of the present invention, the consumer deals with the service provider on behalf of the vendor and the consumer may have a higher degree of confidence in the service provided and thus be more willing to provide information to the service

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provider. The only way that happens is only if the consumer is aware of the service provider.

Applicant needs to claim the feature that makes the customer to be aware of the service provider.

Applicant however does not teach or suggest how the consumer knows who the service provider is, so that the consumer would have confidence in the service provider.

Regarding claim 46 and 58 Tobin teaches the user entering special event and being reminded of the special event. According to applicant's invention a targeted advertisement 86 is included and the advertisement is targeted because the system knows Mary's birthday. The specification indicates if Paul clicks on the advertisement 86, the system may attempt to suggest birthday presents based on Mary's past purchasing habits, items that Mary has looked at on-line or other information. According to Tobin the system know the special event because the user entered the information, and the system provides reminded of the event the user wanted to be reminded about. Therefore it would have been obvious to one of ordinary skill in the art for the retail web site to provide the service included in the Tobin web site for the intended use of reminder a user of special events.

Regarding claim 43 and 55 Examiner would like to point out that the system provides Internet access, which provides option to access email, search the Internet or direct access to the ISP's content providers (see Erickson page 1 col. 3, see also Erickson fig. 1).

Regarding claim 63, Examiner did not assert that today's computer would have a dedicated port and examiner did not assert that the subject matter is well known as of May 31, 2006. Examiner would like to point out that the official notice is taken to show that it is old and well known to make separate parts as an integral of one piece. It would have been obvious to one of ordinary skill in the art at the time of the invention to make the telephone as integral part of the computer

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terminal in order to make the terminal easy to transport. Fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results (In re Lindberg, 194 F.2d 732, 93 USPQ 23 (CCPA 1952)). According to applicant's specification the client system 12, shown in Figure 13, may have a unitary housing including a base 1306 and a monitor 1302, a keyboard 1310 may be stored in a slot 1312 in the base 1306. As a result, the system 12 has an appliance-like, compact appearance.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

  
RETTA YEHDEGA  
PRIMARY EXAMINER